

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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RECTORSEAL, LLC, THE RECTORSEAL CORPORATION, and  
CSW INDUSTRIALS, INC.

Petitioners,

v.

DIVERSITECH CORPORATION,  
Patent Owner.

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IPR2021-00523  
Patent 9,550,223 B2

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Before KEN B. BARRETT, PHILLIP J. KAUFFMAN, and  
MATTHEW S. MEYERS, *Administrative Patent Judges*.

KAUFFMAN, *Administrative Patent Judge*.

TERMINATION

Due to Settlement After Institution of Trial  
35 U.S.C. § 317; 37 C.F.R. § 42.74

On December 20, 2021, with Board authorization, Petitioner and Patent Owner (collectively “the Parties”) filed a Joint Motion to Terminate Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. §§42.72, 42.74. Paper 11 (“Joint Motion”). Along with the Joint Motion, the Parties filed a true copy of their confidential Settlement Agreement (Ex. 1020), as well as a Joint Motion to Treat Settlement Agreement as Business Confidential Information (Paper 12, “Joint Request”). See 37 C.F.R. § 42.74(b) (agreements shall be in writing and a true copy shall be filed), (c) (a party to a settlement may request that the settlement agreement be treated as business confidential and be kept separate from the patent file). In the Joint Motion, the Parties represent that they have reached an agreement to jointly seek termination of the above-identified *inter partes* review proceeding. Joint Motion 2.

We instituted trial on August 27, 2021. See Paper 6 (Institution Decision). Patent Owner has not filed its response. At this early stage of the trial, we have not rendered a final decision on the merits. Because the Parties are jointly requesting termination, and the Office has not yet “decided the merits of the proceeding before the request for termination is filed,” termination of this proceeding with respect to the Petitioner is proper. See 35 U.S.C. § 317(a).

This Order does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

The parties also ask that the Settlement Agreement be treated as business confidential information and be kept separate from the file of the challenged patent. Joint Request 2. We determine that it is appropriate to treat the Settlement Agreement as business confidential information, and to keep that document separate from the file of the challenged patent, pursuant to 37 C.F.R. § 42.74(c).

For the foregoing reasons, it is:

ORDERED that the Joint Motion is granted and this proceeding is terminated with respect to Petitioner and Patent Owner; and

FURTHER ORDERED that the Joint Request that the confidential Settlement Agreement (Ex. 1020) be treated as business confidential information, and be kept separate from the patent file, is granted in this proceeding.

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